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7590 02/27/2008 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			EXAMINER WANG, JIN CHENG	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULLAS GARGI and DANIEL R. TRETTER

Appeal 2007-2104
Application 09/904,627
Technology Center 2600

Decided:

Before JOSEPH L. DIXON, JEAN R. HOMERE, and MARC S. HOFF,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

BACKGROUND

Appellants' invention relates to multimedia database and classification systems, and in particular to automatic classification and retrieval of multimedia files based on the features of the multimedia files (Spec. 1, [0001]). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of visualizing and retrieving a data file from a set of data files comprising:

displaying a plurality of images representing corresponding data files on a display device using a first distance metric between each data file;

redisplaying a portion of the images on the display device using a refined distance metric; and

performing at least one of retrieving, marking, and selecting at least one desired data file.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

BATES	US 5,528,259	Jun. 18, 1996
JAIN	US 6,121,969	Sep. 19, 2000
HIRATA	US 6,240,423 B1	May 29, 2001
MOGHADDAM	US 6,584,221 B1	Jun. 24, 2003

(filed Aug. 30, 1999)

REJECTIONS

Claims 1-7, 11-12, and 16-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hirata.

Claims 8 and 13-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirata, as applied to claims 1 and 17 above, and further in view of Moghaddam.

Claims 9, 10, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirata, as applied to claims 1 and 17 above, and further in view of Jain.

Claim 15 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirata as applied to claims 1 and 17 above, and further in view of Bates.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and Appellants regarding the above-noted rejection, we refer to the Examiner's Answer (mailed Dec. 20, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Jan. 23, 2006) and Reply Brief (filed Feb. 20, 2006) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 102

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the Specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

"It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it

anticipates.” *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002) (citations and internal quotation marks omitted). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

“[A] prima facie case of anticipation [may be] based on inherency.” *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a prima facie case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”). See also *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

Appellants argue that the Hirata patent does not teach redisplaying a portion of the images on the display device using a refined distance metric. (App. Br. 5). The Examiner maintains that Hirata teaches redisplaying a portion of an image on the display device using a refined distance metric wherein the Examiner goes to great length to interpret “redisplaying” and “refined” in an attempt to stretch the teachings of Hirata and citing generally

to figures 1-11 and columns 6-14 (Ans. 3-5 and 17-23). We cannot agree with the Examiner's manipulation of the teachings of Hirata as expressed in the Answer. Therefore, we find that the Examiner has not set forth a sufficient showing to establish a prima facie case of anticipation based upon the teachings of Hirata as advanced in the Answer.

From our review of the teachings of Hirata, we find no specific teachings with respect to redisplaying a portion of an image using a refined distance metric, and the Examiner has not specifically identified any teaching of redisplaying (implying a previous display of a larger set) a portion using a refined (implying changing that which was used previously) distance metric. From our review of the teachings of Hirata, we cannot agree with the Examiner that the step of reading of a database of images in Hirata necessarily requires an initial display of a set of images, then refining a distance metric and redisplaying a portion of that initial set of images based upon the refined distance metric.

While we find it conceivable that skilled artisans may have viewed the initial results and refined the results of the initial query, the teachings of the Hirata patent do not require those steps, as disclosed. Here, the Examiner has rejected the claims based upon anticipation and set forth that Hirata teaches all of the recited limitations. We cannot agree with the Examiner.

Furthermore, the Examiner has not relied upon the rationale that the rejection is based upon the doctrine of inherency. Therefore, we have not relied upon such support in our evaluation, and have looked solely to the

express teachings of Hirata. Since we cannot speculate as to what the artisan would have necessarily done in the search and display process in Hirata, we find that Hirata does not teach all of the limitations recited in independent claim 1. Therefore, we cannot sustain the rejection of independent claim 1, and dependent claims 2-7, 11-12, and 16.

Similarly, we cannot sustain the rejection of independent claim 17 and dependent claims 18 and 19, for the same reasons as discussed above with respect to independent claim 1.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127

S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

With respect to dependent claims 8-10, 13-15, and 20, the Examiner has not identified how the teachings of Moghaddam, Jain, and Bates remedy the noted deficiency, and we do not readily appreciate that these references teach or fairly suggest the invention as recited in independent claims 1 and 17. Therefore, for the reasons noted *supra* with regard to anticipation, we find that the Examiner has not set forth a proper initial showing of obviousness, and we cannot sustain the rejection of the dependent claims 8-10, 13-15 and 20 under 35 U.S.C. § 103.

CONCLUSION

To summarize, we have reversed the rejection of claims 1-7, 11, 12, and 16-19 under 35 U.S.C. § 102, and we have reversed the rejection of claims 8-10, 13-15, and 20 under 35 U.S.C. § 103(a).

REVERSED

rwk

Homere, *Administrative Patent Judge, dissenting.*

I write separately to voice my disagreement with the majority's holding that Hirata does not teach the limitation of redisplaying a portion of previously displayed images on a display device using a refined distance metric, as recited in independent claims 1 and 17. Because of this finding, the majority reverses the Examiner's prior art rejection of claims 1 through 20. From that decision, I respectfully dissent.

The majority opinion states:

From our review of the teachings of Hirata, we find no specific teachings with respect to redisplaying a portion of an image using a refined distance metric, and the Examiner has not specifically identified any teaching of redisplaying (implying a previous display of a larger set) a portion using a refined (implying changing that which was used previously) distance metric. From our review of the teachings of Hirata, we cannot agree with the Examiner that the step of reading of a database of images in Hirata necessarily requires an initial display of a set of images, then refining a distance metric and redisplaying a portion of that initial set of images based upon the refined distance metric.

I agree with the majority that the claimed limitation at issue simply requires that a portion of the previously displayed images (i.e. at least one previously displayed image) be displayed anew upon refining (changing) a distance metric that was previously used to initially display the images. However, I do not agree with the majority's finding that Hirata does not teach that limitation. As depicted in Figure 1, Hirata discloses a matching

phase during which to a COIR engine displays a plurality of data file images retrieved from a multimedia database in response to correlating objects contained in a query image to those contained in the database. (Col. 4, ll. 38-62.) Further, Hirata discloses applying to the search result (i.e. plurality of data file images retrieved by the COIR engine in response to the initial query image) a calculation based on boundary line matching (i.e. refining or changing the query/search) to display anew previously displayed images from the initial retrieved set of images that have partially extracted lines. (Col. 5, l. 65-col. 6, l5.) Additionally, as shown in Figures 8 and 9, Hirata discloses redisplaying the retrieved data file images according to the order of their similarity or distance to the query image. (Col. 6, ll. 20-59.) One of ordinary skill in art would readily recognize that Hirata teaches re-displaying at least one previously displayed data file image upon changing or refining an initial query image by applying boundary line matching to the retrieved data file images. Alternatively, Hirata teaches that limitation by re-displaying said images according to their order of similarity to the query.

I am therefore satisfied that Appellants have not shown that the Examiner erred in finding that Hirata anticipates independent claims 1 and 17. Thus, I cannot agree with the majority's reversal of the Examiner's rejection of the cited claims. Accordingly, I would affirm the Examiner's prior art rejection of independent claims 1 and 17 as being anticipated by Hirata.

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